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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,606	12/05/2003	Allen C. Thompson	10030636-1	2898
22878	7590	03/28/2006	EXAMINER	
AGILENT TECHNOLOGIES, INC. INTELLECTUAL PROPERTY ADMINISTRATION, LEGAL DEPT. P.O. BOX 7599 M/S DL429 LOVELAND, CO 80537-0599			RAMILLANO, LORE JANET	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/729,606	Applicant(s) THOMPSON ET AL.	
	Examiner Lore Ramillano	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
 4a) Of the above claim(s) 20-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 31-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/5/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of **Group I, claims 1-19 and 31-33** in the reply filed on 12/22/05 is acknowledged. The traversal is on the ground(s) that the search and examination of an entire application can be made without serious burden on the examiner. This is not found persuasive because the inventions of Groups I and II are distinct as product and process of use. In addition, the Examiner has met the distinction requirement because the Examiner has shown that the array device may be used in a materially different method, such as a method of purifying or isolating nucleic acids.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-19 and 31-33 are rejected under 35 U.S.C. 112, first paragraph,**

because the specification, while being enabling for the "array assembly," "backing element" ([0062-0070]), and "flexure" property of the "cover", "base", "array assembly," and "backing element," (ie. [0099] and [0100]), does not reasonably provide enablement

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for the “array assembly,” “backing element,” and “flexure” property of the “cover,” “base,” “array assembly,” and “backing element” in the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. In applicant’s specification, it describes the “array assembly” and “backing element” in such a way that they represent structural limitations in applicant’s invention. In addition, the language in the independent claim does not clearly indicate whether the “cover,” “base,” “array assembly,” and “backing element” have the “flexure” property.

4. **Claims 1-19, and 31-33** are rejected under 35 U.S.C. 112, **second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-19, and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: “array assembly,” “backing element,” and “flexure”.

Claims 1, 17, and 31 are indefinite because the following language is unclear: “wherein when said cover is operatively held to said base about a structure.”

Claims 1, 17, and 31 are indefinite because it is unclear what constitutes the “structure” element.

Claim Interpretation

As to **claims 1, 8, 15, 17, and 31**, which contain intended use terms, the Examiner will interpret these claims in light of the structural elements that are disclosed and not for their intended use as stated after the term “for.” It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The Examiner has applied references, which are capable of meeting these functions. A structure, which is capable of providing the intended use, is considered to meet the limitation of intended use recited in a claim to a device or an apparatus.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-8, 14-9, and 31-33** are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (US 5958760).

In Figures 13a and 13b, Freeman discloses a device (Figs. 13a and 13b) comprising a base (114); a cover (128); an array assembly (116); a backing element (6); a clamping member (124); spacers (118); a hardstop (115); and a screw stop (126). In Figures 15a and 15b, Freeman discloses a device with spring elements (212 and 214).

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Freeman further discloses that the force from the clamping member is dissipated over a greater area of the of the array assembly, which creates a capillary gap between the array assembly and backing element (Figures 13a and 13b, column 11, 55-65). Additionally, the travel of the base and cover are limited when are the sealed together by the clamping member (column 3, lines 3-29).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 9-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman in view of Shea et al. (US Pub. No. 20030235906).

Although Freeman discloses a type of force being applied to the array assembly by the clamping, he does not specifically disclose a clamping member flexure or having at least one flexure.

Shea et al. disclose various compression devices, which may comprise a clamping member (48, Figs. 10A-10C), a backing element, and an array substrate ([0082]). Additionally, Shea et al. disclose that the compression devices may be made of a plastic material, such as polypropylene ([0071]).

Freeman and Shea et al. are analogous art because they both represent a type of assay device. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Freeman's device by incorporating the flexure property of Shea et al. because parts of Freeman's invention are made of a synthetic moulded plastics material (column 2, lines 33-43), which would allow these parts to have the flexure property. Therefore, it would have been obvious to combine Freeman and Shea et al. to provide substantially vapor and fluid tight assay area around the array ([0065]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lore Ramillano whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri. 8:30a to 5:00p.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lore Ramillano
Examiner
Art Unit 1743

LJR
3/9/06


Jill Warden
Supervisory Patent Examiner
Technology Center 1700